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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,590	07/10/2003	Michael R. Nowak	P/73-43	3640

7590

06/08/2005

Philip M. Weiss, Esq.  
Weiss & Weiss  
300 Old Country Road, Suite 251  
Mineola, NY 11501

EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/616,590

Applicant(s)

NOWAK, MICHAEL R.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

**WITHDRAWN REJECTIONS**

1. The 35 U.S.C. 102 rejections of claims 3 and 9 as anticipated by Quigg of record in the Office Action mailed December 14, 2004, Page 2 Paragraph 1, have been withdrawn due to Applicant's amendments in the Paper filed March 14, 2005.
2. The 35 U.S.C. 102 rejections of claims 3-5 as anticipated by Hill of record in the Office Action mailed December 14, 2004, Page 3 Paragraph 2, have been withdrawn due to Applicant's amendments in the Paper filed March 14, 2005.
3. The 35 U.S.C. 103 rejection of claim 4 over Quigg in view of Hill of record in the Office Action mailed December 14, 2004, Pages 4-5 Paragraph 3, has been withdrawn due to Applicant's cancellation of claim 4 in the Paper filed March 14, 2005.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "rather than a fully clear ream wrap" renders the claim vague and indefinite because it is not understood what is considered a fully clear ream wrap. Claim 9 is dependent on claim 1, which limits the ream wrap to comprising a clear ream wrap. Therefore it is not understood if the limitation in claim 9 is limiting the ream wrap to further comprising ream wrap that is not clear in combination with the clear ream wrap or that the clear ream wrap of claim 1 further comprises a clear window that is only partially clear, such as a hazy yet transparent window. Clarification is needed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. The 35 U.S.C. 102 rejections of claims 1-2 and 6-7 as anticipated by Quigg are repeated and are rewritten below in order to clearly address the newly added limitations.

Claims 1-2 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Quigg (US 2002/0004732 A1).

Quigg anticipates a ream wrapper comprising one or more printed manufacturer or retailer coupon or coupon booklets which are included inside the wrapped ream of paper, printed on either the inside or outside of said wrapper, and/or attached to an inside surface or outside surface of said ream wrap (p.3, paragraph 26). The ream wrapper further contains a printed advertisement on the ream wrapper (p.3, paragraph 26). The printed coupons attached to the surface of the ream wrap are inherently attached using adhesive backing as suggested in page 5, paragraph 40. The ream wrap is clear (p.4, paragraph 39). In the embodiment of Quigg in which a clear ream wrap is used and the promotional material is face up on the internal surface of the clear ream wrap, one could inherently see said ream of paper and said coupons or said coupon booklets inside said ream wrap without removing said ream wrap from said ream of paper.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. The 35 U.S.C. 103 rejection of claim 5 over Quigg in view of Hill is repeated and is rewritten in combination with newly amended claim 3 in order to better address the newly added limitations.

Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quigg (US 2002/0004732 A1) in view of Hill (USPN 5,645,300).

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Quigg anticipates a ream wrapper for wrapping a ream of paper comprising a ream wrapper, a ream of paper, wherein the ream wrapper wraps the ream of paper. The ream wrapper further contains one or more printed manufacturer or retailer coupon printed on either the inside or outside of said wrapper (p.3, paragraph 26), and teaches that the promotional material includes a redeemable coupon (p.3, paragraph 26). Quigg fails to explicitly teach that solid or dotted lines and/or perforations are formed around the redeemable coupon to enable the consumer to separate the coupon from the wrapper. However, Hill teaches that it is notoriously well known in the art of providing redeemable coupons in wrappers, to use solid or dotted lines and/or perforations to make the coupons easier to separate from the wrapper. It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to combine the teachings of Quigg and Hill since each of the aforementioned references are analogous insofar as being directed at wrappers for containing a product.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to apply solid or dotted lines and/or perforations around the coupons of Quigg, in order to make the coupons easier to separate from the wrapper, as taught by Hill.

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7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quigg (US 2002/0004732 A1) in view of Knauf (US 2004/0213970 A1).

Quigg teaches all that is claimed in claim 1 as shown above, but fail to explicitly teach that the ream wrap comprises a clear window rather than a fully clear ream wrap. Note it is determined for examination purposes that the limitation "rather than a fully clear ream wrap" in light of the specification and drawings is referring to a ream wrap that is not clear having a clear window. Quigg teaches that a ream wrapper is formed from paper, which is not clear, and alternatively teaches that promotional material is placed on the internal surface of the wrapper when the wrapper has a transparent portion, so that the promotional material can be see without opening the wrapper (p.4, paragraph 39). Quigg also teaches an example of a wrapper having a transparent portion, wherein the example taught is that the wrapper is made from clear plastic (p.4, paragraph 39). The alternative embodiment is referring to wrappers in which the promotional material and paper can be seen through the wrapper and by distinctively stating "for example" when referring to wrap of clear plastic, Quigg is not teaching away from other structures performing the same function.



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Knauf teaches that a clear window may be made in Kraft paper ream wrap in order to allow the user to view the color of the paper in the package (p.6, paragraph 81). One of ordinary skill in the art would have recognized that a clear window is formed in Kraft paper ream wrap, such as the primary ream wrap taught by Quigg, in order to allow the customer to view the paper in the package without removing the wrapper. One of ordinary skill in the art would have also recognized that a clear window formed in Kraft paper ream wrap is formed for the same reason forming ream wrap from clear plastic, which is to allow the customer to view the paper and other material within the wrap, such as promotional material, without removing the wrapper, as taught by Quigg and Knauf respectively.

Therefore, it would have been obvious to one having ordinary skill in the art to provide a clear window in the paper ream wrap of Quigg in order to allow the customer to see the paper and other material within the wrap without removing the wrapper, as taught by Knauf, since Quigg teaches that in order to be able to place promotional material on the internal surface of the wrap a transparent material must be present in the ream wrapper.

**ANSWERS TO APPLICANT'S ARGUMENTS**

8. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1-2 and 6-7 as anticipated by Quigg have been fully considered but they are not persuasive.

In response to Applicant's argument that claim 1 requires a clear ream wrap and Quigg requires a paper ream wrap, Quigg also teaches in an alternative embodiment from the embodiment taught in the abstract that the ream wrap is formed of clear wrap (p.4, paragraph 39).

In response to Applicant's argument that Quigg fails to teach that the printed coupons are attached to the ream wrap as claimed in claim 6, Quigg teaches that the coupon can be enclosed within the wrapper, but also teaches that in an alternative embodiment that the coupon is disposed on the enclosure (p.3, paragraph 26). By teaching that instead of enclosing the coupon in the wrapper, the coupon can be disposed on the wrapper, Quigg implicitly teaches that the coupon is attached to the outside of the wrapper.

In response to Applicant's argument that Quigg fails to teach the limitations of claim 2, Quigg specifically teaches that the wrapper includes printed advertisements (p.3, paragraph 26). Although Quigg fails to specifically teach that the advertisement is placed on the ream wrapper in order to notify

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one of inclusion of said coupons inside said ream wrapper, the limitation "notifying one of inclusion of said coupons inside said ream wrapper" is a functional limitation. Functional limitations in an article claim receive little patentable weight, because articles are defined by what the article is, not what it does. In this case, Quigg teaches the structural limitations regarding the advertisement and coupon in relation to the wrapper and ream of paper, and the advertisement is capable of notifying one of inclusion of said coupons.

Furthermore, where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. See MPEP 2112.01 III.

In response to Applicant's argument that Quigg fails to teach that the coupons are attached to the ream wrap as claimed in claim 6, Quigg teaches that the coupon can be enclosed within the wrapper, but also teaches that in an alternative embodiment that the coupon is disposed on the enclosure (p.3, paragraph 26). By teaching that instead of enclosing the coupon in the wrapper, the coupon can be disposed on the wrapper, Quigg implicitly teaches that the coupon is attached to the outside of the wrapper.

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9. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 3 and 9 as anticipated by Quigg have been fully considered but are moot since the rejections have been withdrawn.

10. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 3-5 as anticipated by Hill have been fully considered but are moot since the rejections have been withdrawn.

11. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claim 5 over Quigg in view of Hill have been fully considered but they are not persuasive.

In response to applicant's argument that Quigg and Hill are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are in the field of applicant's endeavor in that both references and the claimed invention are

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related to wrappers for containing a product. In order to determine analogy, the similarities and differences in structure and function of the inventions must be determined. See MPEP 2141.01(a). In this case, both references and the claimed invention have similar structure and functions in that all three inventions refer to a flaccid material that is capable of wrapping objects to be packaged.

#### **Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mueller et al (US 2003/0199218 A1).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes  
Examiner  
Art Unit 1772

*CPB*  
CPB  
June 3, 2005

*S. M. Nalm-Rayford*  
SANDRA NOLAN RAYFORD  
PRIMARY EXAMINER *6-405*  
ACTING SPE, AU 1772